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United States of America

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1943

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No. 136

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CONRAD E. LANGFIELD, doing business as
The Solvite Company,
Petitioner,
vs.
SOLVENTOL CHEMICAL PRODUCTS, INC.,
Respondent

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## BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

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ARTHUR W. DICKEY,
JOHN A. BLAIR,
Counsel for Respondent,
7—141 General Motors Building,
Detroit, Michigan.

Interstate Brief & Record Co., Cass Bldg., 457 Fort St. W., Detroit, Mich.

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### I.

### SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED

The petition for writ of certiorari in this cause seeks a review of a decision of the United States Circuit Court of Appeals for the Sixth Circuit, filed April 6, 1943.

In this litigation, Petitioner challenges two rights of Respondent, Solventhol Chemical Products, Inc., as follows:

1. The right of Respondent to register its trade-mark "Solventol" for use on water soluble cleaning compounds. (This issue is presented by a suit brought by Respondent in the District Court under R. S. 4915, 35 U. S. C. 63, seeking a review of a decision of the Commissioner of Patents.)

2. The right of Respondent to continue the use of its trade-mark "Solventol" on water soluble cleaning compounds. (This issue is presented by Petitioner's counterclaim for trade-mark infringement.)

Both rights are challenged in view of Petitioner's prior registration and use of the trade-mark "Solvite" on a dry cleaning soap which is insoluble in water and can only be used in a hydrocarbon dry cleaning fluid.

While two rights are in question, it is obvious that the right of Respondent to continue the use of its trade-mark "Solventol" is by far the more important. The right to register is clearly ancillary to the right to use. Accordingly, this case, in its most important aspect, is an ordinary suit for infringement of a registered trade-mark.

The petition asserts that the Circuit Court of Appeals refused to give effect to the statute (U. S. C. Title 15, Sec. 96, Petition page 14) which prohibits the use of colorable imitations of registered trade-marks. Petitioner attempts to support this position by the assertion that the Circuit Court of Appeals did not disturb the District Court's finding of trade-mark infringement and by the allegation that no pleading was filed by Respondent deny-

ing the averments of the counterclaim for trade-mark infringement. Both of these assertions are erroneous.

The fact is that the Circuit Court of Appeals expressly held there was no infringement and no likelihood of confusion, saying:

> "Taking into consideration the descriptive syllables of the respective trade-marks in question and the differences in the suffixes and the dissimilarity of the goods on which the respective marks are used, we are of the opinion that the registration of the trade-mark 'Solventol' will not be likely to cause confusion or mistake in the minds of the public and that appellant (Respondent) is entitled to have its mark registered." (Rec. 285-286).
>
> * * * * *
>
> "Disregarding the registerability of Appellant's trade-mark, there is no independent evidence in the record that appellant has infringed upon appellee's common law rights or has competed with appellee unfairly, or that appellant has been guilty of unfair trade practices toward appellee." (Rec. 286).

Moreover, an answer to the counterclaim *was* duly filed and served by Respondent, but through an oversight it was not included in the printed record on appeal. The answer to the counterclaim is printed in the appendix of this brief at pages 15-17, and a certified copy is filed herewith. The Docket Entries in the District Court (Rec. 2) show that the Plaintiff's answer to the counterclaim was filed on March 12, 1940, three days after the counterclaim, itself, was filed. Proof of service of the answer to the counterclaim in the form of an affidavit of Robert L. Boynton, one of the attorneys representing Respondent in the

District Court, is also filed herewith, and the affidavit is printed in the appendix at pages 16-17 of this brief.

The fact that a copy of the answer to the counterclaim was not included in the printed record on appeal was not discovered by Respondent's attorneys until the present petition for a writ of certiorari was served. See the affidavit of John A. Blair, filed herewith and printed at pages 17-18 of this brief.

It is not believed that this Court should grant the present petition merely because of the inadvertent failure to include Plaintiff's answer to Defendant's counterclaim in the printed record, particularly in view of the fact that Petitioner has not previously challenged the sufficiency of the pleadings or the record; and evidence controverting the allegations of the counterclaim was offered and received without objection in the District Court (Federal Rules of Civil Procedure, 15(b)). If the petition is not granted there will be no need to correct the record and, accordingly, Respondent proposes to await the Court's decision on the petition before filing a petition under Rule 17 of this Court to correct diminution of the record.

There remains then, as the only issue in the case, the question of whether or not the Respondent's trade-mark is a colorable imitation of Petitioner's mark. That question is a fact question decided adversely to Petitioner by the Circuit Court of Appeals and not such a question as would justify this Court in granting the writ.

Petitioner complains that the Court of Appeals, in deciding that question, was influenced by the fact that the only common feature of the two marks (the syllable

"Solv") was not distinctive but, on the contrary, was suggestive of the nature of the goods and in common use on such goods. That such is the fact is amply established by evidence that many concerns, both before and since the first use of Petitioner's mark, have employed on cleaning compounds trade-marks beginning with the syllable "Solv." (Rec. 87, 176-183, and Plaintiff's Exhibits 46-64, inclusive, Rec. 242-261.) As hereinafter pointed out, that circumstance, while not conclusive, is universally regarded as one that must be taken into consideration in weighing the question of trade-mark infringement.

The evidence establishes the existence of many other facts negativing likelihood of confusion in the trade and, therefore, negativing infringement. Among them may be mentioned the following:

1. The trade-marks as a whole ("Solventol" and "Solvite") are materially different. (Compare Plaintiff's Exhibit 2, Rec. 132-133, with Plaintiff's Exhibit 7, Rec. 219.)

2. The goods on which the marks are used are different and non-competitive. Petitioner's trade-mark is registered for use and is used only on a dry cleaning soap which can only be used in gasoline or naphtha for dry cleaning operations, while Respondent's goods can only be used in water for ordinary washing operations. (Plaintiff's Exhibit 7, Rec. 219 and Rec. 206-215.)

3. Petitioner's dry cleaning soap is sold at retail only in drug stores (Rec. 36-37 and Plaintiff's Exhibits 34 and 35, Rec. 227), while less than two-tenths of one per cent of Respondent's cleaner has been sold in drug stores (Plaintiff's Exhibit 36, Rec. 228).

4. The dress of the goods is entirely different. (Compare Plaintiff's physical Exhibits 8 and 40.*)

5. Petitioner's business is almost non-existent, amounting to less than One Thousand Dollars per year, and hence the reputation of his trade-mark is limited compared with that of Respondent. (See Findings of Fact No. 9 of District Court, Rec. 265, and opinion of Circuit Court of Appeals, Rec. 281-282, which are based on Defendant's answers to Plaintiff's Interrogatories, Rec. 11-33, and Plaintiff's Exhibit 36, Rec. 228.)

These are all matters of fact that entered into the Circuit Court of Appeals decision of the ultimate fact question of likelihood of confusion.

## II.

## SUMMARY OF ARGUMENT

The Trade-Mark Act of February 20, 1905 (Title 15, Sec. 96, U. S. C.), in so far as it prohibits the use of "colorable" imitations of registered trade-marks, merely prohibits such imitation as is calculated to mislead the public with respect to the origin of the goods.

*American Steel Foundries v. Robertson,* 269 U. S. 372, 381; 70 L. Ed. 317, 321.

*Armstrong Paint and Varnish Works v. Nu-Enamel Corp.,* 305 U. S. 315, 335; 83 L. Ed. 195, 207.

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*Specimens of the containers in which the goods of the respective parties are sold are transmitted herewith. They correspond to Plaintiff's physical Exhibits 8 and 40, which are in the possession of the Circuit Court of Appeals. Plaintiffs Exhibit 40 is Respondent's smallest size container. The other containers of Respondent differ only in size.

*Thaddeus Davids Co. v. Davids,* 233 U. S. 461, 470; 58 L. Ed. 1046, 1050.

The question of whether or not Respondent's mark is calculated to mislead the public is a fact question decided adversely to Petitioner by the Circuit Court of Appeals, and certiorari is not granted merely to review evidence or inferences drawn therefrom.

*General Talking Pictures Corp. v. Western Electric Co., Inc.,* 304 U. S. 175, 178; 82 L. Ed. 1273, 1275.

*Southern Power Company v. North Carolina Public Service Company,* 263 U. S. 508, 509; 68 L. Ed. 413.

*Magnum Import Co. v. De Spoturno Coty,* 262 U. S. 159, 163; 67 L. Ed. 922, 924.

In deciding the single question presented, the Circuit Court of Appeals properly took into consideration, along with other facts, the non-distinctive character of the only feature common to the trade-marks of the parties.

*American Steel Foundries v. Robertson,* 269 U. S. 372, 382-384; 70 L. Ed. 317, 321-322.

*Pabst Brewing Co. v. Decatur Brewing Co. et al.,* 284 F. 110 (CCA 7).

*Burger Brewing Co. v. Maloney-Davidson Co. et al.,* 86 F. (2d) 815 (CCA 6).

*Valvoline Oil Co. v. Havoline Oil Co., et al.,* 211 F. 189 (D. C. S. D. N.Y.).

*Arrow Distilleries, Inc., v. Globe Brewing Co.,* 117 F. (2d) 347 (CCA 4).

*Thomas Kerfoot & Co., Ltd., v. Louis K. Liggett Co.,* 67 F. (2d) 214 (CCA 1).

*Herman Nelson Corp v. Columbus Heating & Ventilating Co.,* 11 F. (2d) 273, 277 (CCA 6).

*Restatement of the Law of Torts,* Chapter 35, Sec. 729, comment g; Chapter 35, Sec. 733, comment b.

The rule of *Morgan v. Daniels,* 153 U. S. 120, 125, to the effect that decisions of the Patent Office must be accepted as controlling unless the contrary is established by evidence which carries thorough conviction, has no bearing upon the issue of trade-mark infringement, and it was not violated by the Circuit Court of Appeals decision holding Respondent's trade-mark registerable.

*California Packing Corp. v. Tillman & Bendel, Inc.,* 40 F. (2d) 108, 113 (CCPA).

*Goodrich Co. v. Kenilworth Mfg Co., Inc.,* 40 F. (2d) 121, 122 (CCPA).

No new or important question is involved and there is presented no conflict with decisions of this Court or between decisions of the Circuit Courts of Appeal of different circuits.

## III.

## ARGUMENT

The Trade-Mark Act of February 20, 1905, in so far as it seeks to define substantive rights, is simply an expression of the common law. *American Steel Foundries v. Robertson,* 269 U. S. 372, 381; 70 L. Ed. 317, 321. Accordingly, U. S. C. Title 15, Section 96 (Petition page 14), in prohibiting the use of "colorable" imitations of registered trade-marks, has been construed to prohibit only the use of such marks as will be likely to cause confusion in the trade. In *Armstrong Paint and Varnish Works v. Nu-Enamel Corp.,* 305 U. S. 315, 335; 83 L. Ed. 195, 207, this court, in discussing what it described as

"substantially the same" provision in the Trade-Mark Act of March 19, 1920 (U. S. C. Title 15, Section 124*), said:

> "As was pointed out in the Davids case, in considering the ten year clause of the 1905 Act, this right (provided in U. S. C. Title 15, Section 124) of freedom does not confer a monopoly on the use of words. It is a mere protection against their unfair use as a trade-mark or a trade-name by a competitor seeking to palm off his products as those of the original user of the trade-name."

In the Davids case (*Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 470; 58 L. Ed. 1046), the court said, in discussing the scope of protection afforded the owner of a trade-mark registered under the Act of 1905:

> "* * * the reproduction, copy or imitation which constitutes infringement must be such as is calculated to mislead the public with respect to the origin or ownership of the goods, and thus to invade the right of the registrant to the use of the name or terms as a designation of his merchandise."

It is exactly that question which was decided adversely to Petitioner by the Circuit Court of Appeals after a consideration of all the facts and circumstances established by the evidence. The question is one of fact, and certiorari is not granted merely to review facts. In *General Talking Pictures Corp. v. Western Electric Company, Inc.*, 304 U. S. 175, 178; 82 L. Ed. 1273, 1275, the Court said:

> "Granting of a writ would not be warranted merely to review the evidence of inferences drawn from it."

*See appendix, page 19 of this brief.

See, also, *Southern Power Company v. North Carolina Public Service Company,* 263 U. S. 508, 509; 68 L. Ed. 413; *Magnum Import Co. v. De Spoturno Coty,* 262 U. S. 159, 163; 67 L. Ed. 922, 924.

The Circuit Court of Appeals, in deciding this fact question, properly considered, among other evidence, that the only common feature of the trade-marks of the parties was a non-distinctive and suggestive syllable. This and other courts have uniformly held that circumstance has an important bearing upon the scope of protection to which a trade-mark owner is entitled.

*American Steel Foundries v. Robertson,* 269 U. S. 372, 383-384; 70 L. Ed. 317, 321-322.

*Pabst Brewing Co. v. Decatur Brewing Co. et al.,* 284 F. 110 (CCA 7).

*Burger Brewing Co. v. Maloney-Davidson Co. et al.,* 86 F. (2d) 815 (CCA 6).

*Valvoline Oil Co. v. Havoline Oil Co., et al.,* 211 F. 189 (D. C. S. D. N. Y.).

*Arrow Distilleries, Inc. v. Globe Brewing Co.,* 117 F. (2d) 347 (CCA 4).

*Thomas Kerfoot & Co., Ltd. v. Louis K. Liggett Co.,* 67 F. (2d) 214 (CCA 1).

*Herman Nelson Corp. v. Columbus Heating & Ventilating Co.,* 11 F. (2d) 273, 277 (CCA 6).

The *Restatement of the Law of Torts,* Chapter 35, states the rule as follows:

> "Not all trade-marks are equally effective in sales stimulation. Some are effective because they are unique, as, for example, Kodak; others are less effective because common, as, for example, Simplex or Blue Ribbon. The greater the number of identical or more or less similar trade-marks

> already in use on different kinds of goods, the less is the likelihood of confusion, apart from the other factors mentioned in this section." (Section 729, comment g.)
>
> * * * * *
>
> "Failure by the prior user of a trade-mark or trade-name to take effective steps to prevent subsequent use of a similar designation by another may narrow the class of goods or the territorial markets with reference to which his priority would otherwise entitle him to exclude others." (Section 733, comment b.).

The petition asserts that the above stated rule was abandoned by the Second Circuit Court of Appeals in the case of *Landers, Frary & Clark v. Universal Cooler Corp.*, 85 F. (2d) 46, 48, involving the trade-mark "Universal". This statement is erroneous and the excerpt in the petition (page 9) is misleading and incomplete. The court actually stated the rule with approval and merely pointed out that lack of distinctiveness was not conclusive against the owner of the non-distinctive mark. Thus, following the quotation appearing in the petition, the court said:

> "The proprietary connotation, — 'secondary meaning',—of a word of common speech is harder to create and easier to lose, and its fringe or penumbra does not usually extend so far as that of a coined word. But that is a matter of proof and proof alone; if the owner can in fact show that the fringe does extend to other goods there is no reason why his interest should not be recognized."

In the instant case, there is no evidence as to the extent that the trade-mark "Solvite" is associated in the public mind with Petitioner and all the evidence strongly indi-

cates that it can have only a most limited reputation in the limited field of dry cleaning soaps. The reputation, if any, attached to Petitioner's mark cannot possibly extend to the distinctly different field of water soluble cleaners, let alone engulf a different mark in that field. No confusion in the trade with respect to the source of Respondent's goods was shown even after many years use of Respondent's mark in the same territories in which Petitioner did business.

The Petitioner asserts (Petition page 9) that the Circuit Court of Appeals should have accepted the fact of confusing similarity found by the Patent Office under the rule of *Morgan v. Daniels,* 153 U. S. 120. However, the Circuit Court of Appeals recognized that Respondent, in so far as the issue of registration was concerned, had sustained the burden imposed by the case of *Morgan v. Daniels* by adducing new evidence at the trial in the District Court. This is clear since the Circuit Court of Appeals, in its opinion, referred to the rule of *Morgan v. Daniels* and recited some of the facts established by the new evidence.*

Moreover, the primary issue in this case is the issue respecting Respondent's right to continue the *use* of its trade-mark. *Morgan v. Daniels* has no application to that issue because the Commissioner of Patents in trade-mark opposition proceedings has no jurisdiction over and is not interested in the question of trade-mark infringement. This is clearly indicated by the decisions of the Court

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*The evidence of shoppers who called on three hundred stores in Detroit, Michigan, without encountering any confusion, the evidence respecting the relative sizes of the business of the parties and the evidence of the widespread use on cleaning compounds of trade-marks beginning with the syllable "Solv", all of which was referred to by the Circuit Court of Appeals, was evidence not before the Commissioner of Patents. There was other new evidence introduced in the District Court.

of Customs and Patent Appeals, which has appellate jurisdiction over the Commissioner of Patents in trade-mark registration proceedings (including oppositions and cancellations). Thus that court, in *California Packing Corp. v. Tillman & Bendel, Inc.*, 40 F. (2d) 108, 113 (CCPA), said:

> "We are only concerned in this action (an opposition proceeding) with appellee's right of *registration* of the trade-mark and not with its *use* of the same. As to whether appellee, in law, has the right to use the trade-name 'Del Monte' on coffee in containers of any description, or whether it has the right to use it in markets confined to the West Coast or throughout the world, are questions not before us and are not decided."

To the same effect is that court's decision in *Goodrich Co. v. Kenilworth Mfg. Co., Inc.*, 40 F. (2d) 121, 122.

## CONCLUSION

In all essential aspects, this case is an ordinary case presenting the question of trade-mark infringement. The only issue in the case is a fact question decided by the Circuit Court of Appeals with due regard to well established principles of law. There is presented no new or important question and there exists no conflict between the decision of the Circuit Court of Appeals in this case and the decisions of the Supreme Court or other Circuit Courts of Appeal.

Under the circumstances, no ground appears for granting the petition and it is respectfully submitted that it should be denied.

ARTHUR W. DICKEY,
JOHN A. BLAIR,
*Counsel for Respondent.*